

APPENDIX B
INTERFERING CLAIMS CORRESPONDING TO THE COUNT
37 C.F.R. 41.202(a)(3)

Count 1	Claim 1 of the Present Application	Claim 1 of U.S. Patent No. 6,530,026	Claim 1 of U.S. Patent No. 7,056,321
A method of fixing vertebrae of a patient together at a surgical site, the method comprising the steps of: inserting a cannula into the patient;	1. A method of fixing vertebrae of a patient together at a surgical site, the method comprising the steps of: inserting a cannula into the patient;	1. A method of fixing vertebrae of a patient together at a surgical site comprising the steps of: inserting a first cannula into the body of the patient;	1. A method of fixing first and second vertebrae of a patient together at a surgical site comprising the steps of: inserting a first cannula into the body of the patient;
inserting a first fixation element through the cannula and securing the first fixation element to a first vertebra;	inserting a first fixation element through the cannula and securing the first fixation element to a first vertebra;	moving a first fastener through the cannula and securing the first fastener to a first vertebra;	moving a fusion device through the cannula and inserting the fusion device between the first and second vertebrae;
inserting a second fixation element through the cannula and securing the second fixation element to a second vertebra;	inserting a second fixation element through the cannula and securing the second fixation element to a second vertebra;	moving a second fastener through the cannula and securing the second fastener to a second vertebra;	moving a first fastener through the cannula and inserting the first fastener between the first and second vertebrae;
inserting a third fixation element through the cannula and securing the third fixation element to the first and second fixation elements.	inserting a third fixation element through the cannula and securing the third fixation element to the first and second fixation elements.	moving a first fixation element through the cannula and fixing the first fixation element to the first and second fasteners.	moving a second fastener through the cannula and securing the second fastener to a second vertebra;
			moving a first fixation element through the cannula; and fixing the first fixation element to the first and second fasteners after at least one of the fasteners has been secured to the first or second vertebra.

Explanation as to why the claims interfere under 37 C.F.R. § 41.202(a)(3):

Claim 1 of the Present Application v. Claim 1 of U.S. Patent No. 6,530,926

Claim 1 of the present application interferes with claim 1 of the '926 patent under the two-way test set forth in 37 C.F.R. § 41.202(a)(3). Claim 1 of the present application and claim 1 of the '926 patent recite methods of fixing vertebrae of a patient together at a surgical site. Claim 1 of the '926 patent is essentially the same as claim 1 of the present application, except that claim 1 of the present application recites first, second and third fixation elements (*e.g.*, 2 pedicle screws and 1 plate), whereas claim 1 of the '926 patent recites first and second fasteners (*e.g.*, 2 pedicle screws) and a first fixation element (*e.g.*, a plate). This difference in claim terminology used to describe vertebral fixation elements, such as plates and screws, is insignificant to a person skilled in the art of vertebral fixation elements. Accordingly, claim 1 of the '926 patent does not define a patentably distinct invention with respect to claim 1 of the present invention, and the subject matter of claim 1 of the present invention would, if prior art, have anticipated or rendered obvious the subject matter of claim 1 of the '926 patent and vice versa.

Claim 1 of the Present Application v. Claim 1 of U.S. Patent No. 7,056,321

Claim 1 of the present application interferes with claim 1 of the '321 patent under the two-way test set forth in 37 C.F.R. § 41.202(a)(3). Claim 1 of the '321 patent is essentially the same as claim 1 of the present application, except that (a) claim 1 of the present application recites first, second and third fixation elements (*e.g.*, 2 pedicle screws and 1 plate), whereas claim 1 of the '321 patent recites first and second fasteners (*e.g.*, 2 pedicle screws) and a first fixation element (*e.g.*, a plate); (b) claim 1 of the '321 patent recites the additional steps of moving a fusion device through the cannula and inserting the fusion device between first and second vertebrae of a patient; and (c) claim 1 of the '321 patent recites fixing the first fixation element to the first and second fasteners "after at least one of the fasteners has been secured to the first or second vertebra."

However, with respect to (a), as discussed above for claim 1 of the '926 patent, the difference in claim terminology for the vertebral fixation elements, *i.e.*, "fastener" vs. "fixation element," is insignificant. With respect to (b), the use of fusion devices in

connection with fixation elements was known in the art prior to the effective filing date of the '321 patent. See, e.g., U.S. Patent No. 5,569,248. With respect to (c), the procedure of securing a first pedicle screw to a first vertebra, securing a second pedicle screw to a second vertebra, and then securing a plate to the first and second pedicle screws was well known in the art. See, e.g., U.S. Patent No. 5,395,371 at col. 6, lines 28-46 ("Once a pedicle screw means 40 has been threaded into each of the tapped openings in the vertebrae V, the fixation plate 13 can be placed against the articular surfaces 47 of each of the pedicle screw means 40 . . ."); U.S. Patent No. 5,196,015 at col. 1, lines 21-27 ("Instrument systems that accomplish spinal fixation are known in the form of pedicle screws which are adapted to be inserted in selected vertebrae, and stiff rods or plates that connect adjacent pedicle screw heads to one another after the screws are inserted, thus resulting in the fixing or bracing of all vertebrae spanned by the rod or plate."). Accordingly, these additional recitations in claim 1 of the '321 patent do not define separately patentable subject matter with respect to claim 1 of the present application, and the subject matter of claim 1 of the present invention would, if prior art, have anticipated or rendered obvious the subject matter of claim 1 of the '321 patent and vice versa.

Count 2 A method of fixing vertebrae of a patient together at a surgical site, the method comprising the steps of:	Claim 7 of the Present Application 7. A method of fixing vertebrae of a patient together at a surgical site, the method comprising the steps of:	Claim 15 of U.S. Patent No. 6,530,926 15. A method of fixing vertebrae of patient together at a surgical site comprising the steps of:	Claim 23 of U.S. Patent No. 7,056,321 22. A method for providing treatment at or near the spine of patient, the method comprising:
inserting a cannula into the patient;	inserting a cannula into the patient;	inserting a first cannula into the body of the patient;	providing an elongate body having a proximal end, a distal end, an outer surface and an inner surface, said inner surface defining a passage extending through the elongate body and through which surgical instruments can be inserted to a surgical location proximate the spine;
			inserting said distal end of said elongate body into the patient such that the distal end resides proximate the surgical location, the proximal end remaining outside the patient;
expanding the cannula;		[see last claim element] expanding the cannula;	[see last claim element] moving a first fastener through the cannula and securing the first fastener to a first vertebra;
inserting a first fixation element through the cannula and securing the first fixation element to a first vertebra;		inserting a first fixation element through the cannula and securing the first fixation element to a first vertebra;	coupling the first implant with a first vertebra;
inserting a second fixation element through the cannula and securing the second fixation element to a second vertebra; and		inserting a second fixation element through the cannula and securing the second fixation element to a second vertebra;	coupling the second implant with a second vertebra;

Count 2	Claim 7 of the Present Application	Claim 15 of U.S. Patent No. 6,530,926	Claim 23 of U.S. Patent No. 7,056,321
inserting a third fixation element through the cannula and securing the third fixation element to the first and second fixation elements.	inserting a third fixation element through the cannula and securing the third fixation element to the first and second fixation elements.	moving a first fixation element through the cannula; fixing the first fixation element to the first and second fasteners; and	inserting a spanning member into the elongate body; and coupling the spanning member with the first and second implants
			after at least one of the implants has been coupled to the first or second vertebra.
		expanding the first cannula at its end adjacent the first and second vertebrae	23. The method of claim 22, further comprising expanding the elongate body after the distal end of the elongate body is proximate the surgical location.

Explanation as to why the claims interfere under 37 C.F.R. § 41.202(a)(3):

Claim 7 of the Present Application v. Claim 15 of U.S. Patent No. 6,530,926

Claim 7 of the present application interferes with claim 15 of the '926 patent under the two-way test set forth in 37 C.F.R. § 41.202(a)(3). Claim 7 of the present invention and claim 15 of the '926 patent recite a methods of fixing vertebrae of a patient together at a surgical site. Claim 15 of the '926 patent is essentially the same as claim 7 of the present application, except that (a) claim 7 of the present application recites first, second and third fixation elements (*e.g.*, 2 pedicle screws and 1 plate), whereas claim 15 of the '926 patent recites first and second fasteners (*e.g.*, 2 pedicle screws) and a first fixation element (*e.g.*, a plate); and (b) claim 7 of the present application recites "expanding the cannula," whereas claim 15 recites "expanding the first cannula at its end adjacent the first and second vertebrae." Neither of these differences renders claim 15 patentably distinct from claim 7 of the present invention. For example, as discussed above, the difference in terminology used for vertebral fixation elements, *i.e.*, "fastener" vs. "fixation element," is insignificant. Furthermore, the recitation in claim 7 of the present application of "expanding the cannula" obviously

contemplates a cannula that is expanded “at its end adjacent the first and second vertebrae,” as recited in claim 15 of the ‘926 patent. Accordingly, the subject matter of claim 7 of the present invention would, if prior art, have anticipated or rendered obvious the subject matter of claim 15 of the ‘926 patent and vice versa.

Claim 7 of the Present Application v. Claim 23 of U.S. Patent No. 7,056,321

Claim 7 of the present application interferes with claim 23 of the ‘321 patent under the two-way test set forth in 37 C.F.R. § 41.202(a)(3). Claim 23 of the ‘321 patent recites a method for providing treatment at or near the spine. Claim 23 of the ‘321 patent is essentially the same as claim 7 of the present application, except that (a) count 2 recites a “cannula” whereas claim 23 recites “an elongate body” and various well-known features of a cannula such as a proximal end, a distal end, an outer surface, etc., (b) claim 7 of the present application recites first, second and third fixation elements (*e.g.*, 2 pedicle screws and 1 plate), whereas claim 23 recites first and second “implants” (*e.g.*, 2 pedicle screws) and a “spanning member” (*e.g.*, a plate); (c) claim 23 of the ‘321 patent recites fixing the first fixation element to the first and second fasteners “after at least one of the fasteners has been secured to the first or second vertebra,” and (d) claim 7 of the present application recites “expanding the cannula,” whereas claim 23 recites “expanding the elongate body after the distal end of the elongate body is proximate the surgical location.” None of these differences renders claim 23 patentably distinct from claim 7 of the present application. For example, with respect to (a), the term “elongate body” and its recited conventional features is patentably indistinguishable from a cannula. With respect to (b), the difference in terminology used for vertebral fixation elements, *i.e.*, “implant” vs. “fixation element,” is insignificant. With respect to (c), the procedure of securing a first pedicle screw to a first vertebra, securing a second pedicle screw to a second vertebra, and then securing a plate to the first and second pedicle screws was well known in the art, as discussed above. *See, e.g.*, U.S. Patent Nos. 5,395,371 and 5,196,015. With respect to (d), the recitation in claim 7 of the present application of “expanding the cannula” obviously contemplates a cannula that is expanded after its distal end is proximate to the surgical location. Accordingly, the subject matter of claim 7 of the present invention would, if prior art, have anticipated or rendered obvious the subject matter of claim 1 of the ‘321 patent and ‘vice versa.